

REMARKS

The formal allowance of claims 1, 12, 20, 25 and 30-32 is appreciated. The objection to claim 1 has been overcome by deleting the extra space after the word "section" in line 5 of claim 1.

In the Office Action of March 23, 2004, claims 2-4, 8 and 9 were rejected under § 112 as being indefinite. Pursuant to the above amendments, claim 2 has been canceled with the dependency of claims 3 and 4 being amended to depend from claim 1 and the term "weighted portion" in claim 8 has been amended to - - weighted section - - to provide proper antecedent basis.

With these amendments, claims 2-4, 8 and 9 are in condition for allowance and such action is respectfully requested.

Independent claim 26 and dependent claims 27, 29 and 34 were rejected under § 102(b) as being anticipated by the Keeton Patent No. 5, 144,765. The Keeton patent has been carefully considered and claim 26 has been amended to more clearly define the present invention and to clearly distinguish from *Keeton*.

Keeton is directed to a dual noise making device for a fishing lure which includes a tapered body member 12, an elongated portion 16 and a collar member 20. The collar 20 is required to be loosely disposed on the elongated portion 16 so that as the device moves through the water, the collar 20 moves relative to the portion 16 to create a noise attractive to fish. As disclosed in *Keeton*, the collar 20 may be solid as shown in Figure 1 or hollow as shown in Figure 2. The hollow version of Figure 2 includes a plurality of metallic balls 34. An essential feature of *Keeton* is the requirement that the collar 20 be loosely mounted to the projection 16 so that it can move relative to the portion 16 and contact the member 12 to make a noise attractive to fish as the device moves through the water. In fact, each of the claims requires this particular structure. A further essential feature of *Keeton* is that it provide a "dual" noise making device for lures. The "dual" feature comprises the noise made by the loosely mounted collar 20 on the portion 16 and noise made by the the metallic balls 34 within the hollow 32 of the collar 20 of Figure 2.

Independent claim 26 has been amended to require the hollow member to be "immovably fixed to said elongated body". As so amended, claim 26 is clearly distinguishable from *Keeton*.

To the extent *Keeton* discloses a hollow member in the form of the hollow collar 20 of Figure 2, such collar 20 is not immovably fixed to any portion of the lure device. Instead, as shown and disclosed, the hollow collar 20 is required to be mounted relative to the portion 16 and the member 12 so that it is movable relative to these elements. This enables the hollow collar 20 to create a noise attractive to fish as the collar contacts the base portion 13 of the member 12 (column 5, lines 44-49). Accordingly, claim 26 as amended is not anticipated under § 102(b) by *Keeton*.

Independent claim 26 as amended is also distinguishable from *Keeton* in view of § 103. The requirement of claim 26 (amended) that the hollow member be “immovably fixed to said elongated body” is in direct contradiction to an essential structural feature of *Keeton*. As indicated above, the requirement that the collar 20 be loosely mounted to the portion 16 so that it is movable relative to the portion 16 and the member 11 is an essential and critical feature of the *Keeton* invention (see the Summary of Invention – column 1, line 55 through column 2, line 66 and each of the *Keeton* claims). Thus, immovably fixing the collar 20 to the portion 16 or the member 12 would not be an obvious modification.

Accordingly, independent claim 26 and its respective dependent claims 27-29 and 34 are allowable and their formal allowance is respectfully requested.

Each of dependent claims 27, 28, 29 and 34 was also rejected under either § 102(b) as being anticipated by *Keeton*, or under § 103(a) as being obvious over *Keeton* in view of Ravencroft Patent No. 6,155,000 or the Enomoto Patent No. 5,428,919.

Because claims 27, 28, 29 and 34 depend from independent claim 26, such claims are patentable for the same reasons as independent claim 26 discussed above. Further, none of the secondary references applied in connection with the § 103(a) rejection discloses the combination of elements of claim 26 including, particularly, a hollow member “immovably fixed to said elongated body”. Even if they did, as indicated above, it would not have been obvious to modify *Keeton* to include such a feature because such modification would be inconsistent with an essential feature of *Keeton*.

Accordingly, the specific rejections of dependent claims 27, 28, 29 and 34 have been overcome and such claims are in condition for allowance.

Claim 38 was rejected under § 102(b) as being anticipated by the North Patent No. 5,946,847. Independent claim 38 has been amended to more clearly define the present invention and to clearly distinguish from *North*.

The North patent is directed to clicking capsules for fishing lures and discloses a clicking capsule such as shown in Figures 1 and 3 for insertion into plastic fishing lures or inserted into cavities provided in hard body lures.

Independent claim 38 as amended is not anticipated by North for several reasons. First, claim 38 is directed to a “fishing sinker”. This is in contrast to the North patent which is directed to clicking capsules for “fishing lures”. Fishing “sinker” and fishing “lures” are different products used by fishermen and perform entirely different functions. A fishing “sinker” is not provided with a hook and is used to cause the fishing line and/or lure to sink in the water. In contrast, a fishing “lure” is provided with a hook and may or may not be provided with means to cause the lure to sink in water. The North patent discloses only application of the clicking capsule in connection with a fishing “lure” and does not disclose use in connection with a fishing “sinker”. Second, for the reasons discussed below in response to the § 103 rejection, *North* also fails to disclose a first end of a hollow member molded into the weighted section at said free end. Thus, independent claim 38 is not anticipated by the North patent.

Further, claim 38 has been rejected under § 103(a) as being unpatentable over North. Claim 38, as amended, requires the body to have a line connection end and an “opposite” free end and for the weighted section to be “located at said free end”. Claim 38 (amended) also requires the hollow member to have “first and second ends”, with the “first end being molded into said weighted section at said free end”. To the extent the North patent discloses a body with a line connection end and an opposite free end, the free end is provided with a hook or hook means. This is an essential structural feature of the North patent because it is a “fishing lure” rather than a “fishing sinker”.

Further, claim 38 amended requires a hollow member with first and second ends, with said first end being molded into the weighted section. Such a structural feature is not shown or disclosed in *North*. As disclosed in *North*, the clicking capsule is either inserted into a flexible, plastic body or into a cavity of a hard body lure. There is absolutely no disclosure that the clicking capsule or any other hollow member of *North* is “molded” into the weighted section. In

fact, molding the clicking capsule or any other hollow member into the lure body of *North* would be inconsistent with its teachings, and thus not obvious.

Still further, claim 38 amended requires the first end of the hollow member to be molded into the weighted section "at said free end". This is not disclosed or suggested in *North*. In all embodiments of *North*, the clicking capsule is inserted into the interior of the lure somewhere near the middle thereof.

Accordingly, independent claim 38 is believed to be patentable over the *North* patent.

New claims 41 and 42 have been added to more fully claim the present invention. These claims depend from independent claim 38 and thus are patentable for the same reasons as claim 38.

For all of the above reasons, it is submitted that all of the claims in the present application are now in condition for allowance and such action is respectfully requested.

Respectfully submitted,

DORSEY & WHITNEY LLP

Customer Number 25763

Date: Aug. 23, 2004

By: David N. Fronek
David N. Fronek (Reg. No. 25,678)
Intellectual Property Department
Suite 1500, 50 South Sixth Street
Minneapolis, MN 55402-1498
(612) 340-2629